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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/549,546

09/14/2005

Martine Barth

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MERCHANT & GOULD PC

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EXAMINER

MURRAY, JEFFREY H

ART UNIT

PAPER NUMBER

1624

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,546	<b>Applicant(s)</b> BARTH ET AL.	
	<b>Examiner</b> JEFFREY H. MURRAY	<b>Art Unit</b> 1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. This action is in response to a non-final rejection filed on December 26, 2007. There are eleven claims pending and six claims under consideration. Claims 4-6, 8, and 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. This is the second action on the merits. The present invention relates to novel compounds of benzenesulfonamide type, their method of preparation and their use to obtain pharmaceutical compositions.

***Status of Objections***

2. The specification is objected to as not containing a proper abstract of the disclosure. The objection to the abstract for not containing the proper content is hereby withdrawn in view of applicants' submitted amendment. However, the new abstract of the disclosure is objected to because it exceeds 150 words in length. The maximum length for an abstract is 150 words. See MPEP § 608.01(b). Examiner recommends removing the words immediately following the structure of Formula (I) through the third from the bottom line of page 1 of the abstract which ends with, "...two C<sub>1</sub>-C<sub>4</sub> groups." Appropriate correction is required.
3. The specification was objected to for being vague with regards to the R groups agreeing in number with the subject matter. In view of applicants' submitted amendments, the objection is hereby withdrawn.

***Status of Rejections***

4. Claims 1-3 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The amendments made by the applicants have been noted, and the rejection is hereby withdrawn.
5. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the definiteness requirement. The arguments made by the applicants have been noted and found convincing, and the rejection is hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

***New Objections***

***Claim Objections***

6. Claim 1-3 and 7 are objected to because of the following informalities: Claim 1 defines Y as "Y represents a saturated C<sub>3</sub>-C<sub>5</sub> alkylene group, interrupted by an oxygen atom,..." When applicant elected Group II from the restriction requirement on June 13, 2007, Group II explicitly defined Y as, "Y is a -CH<sub>2</sub>CH<sub>2</sub>OCH<sub>2</sub>- group". Applicants have defined Y broader than was permitted within the restriction requirement. No new matter is permitted. Appropriate correction is required.

7. Claim 11 is objected to because of the following informalities: Claim 11 defines, A composition..." whereas claim 7 defines "A therapeutic composition..." It is suggested that applicants be consistent in using this terminology. Examiner suggests amending Claim 11 to read, "A pharmaceutical composition..." or "A therapeutic composition..." No new matter is permitted. Appropriate correction is required.

***New Rejections***

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3, 7, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 read, "A benzenesulphonamide derivative compound..." and claims 2, 3, 7 and 11 refer back to "a compound." The term "benzenesulphonamide

derivative” can make the claims unusually broad in scope (what derivatives?).

Therefore, the examiner suggests removing the term “benzenesulphonamide derivative” from claims 1 and 10 so that they read, “A compound, selected from...”. Appropriate correction is required.

Claim 1 reads, “a) compounds of formula...” Applicant is only entitled to a single invention. The phrase “*compounds* of the formula...” does not agree in number with the beginning of the claim which states, “A benzenesulphonamide *compound*...”.

Therefore, the examiner suggests replacing the term “compounds” with “compound.” Appropriate correction is required.

### ***Conclusion***

10. Claims 1-3, 7, 10 and 11 are rejected.

11. Claims 1-3, 7 and 11 are objected.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1624

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Patent Examiner  
Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner  
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